



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2022-0032]

Expanding Opportunities to Appear Before the Patent Trial and Appeal Board

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Request for comments.

SUMMARY: In this request for comments, the United States Patent and Trademark Office (USPTO or Office) seeks public input on the requirements to practice before the Patent Trial and Appeal Board (PTAB or Board). The Office seeks to ensure quality representation in PTAB proceedings under the Leahy-Smith America Invents Act (AIA) without creating undue restrictions or barriers to entry for practitioners wishing to appear before the PTAB. The Office's goal is to expand the admission criteria to practice before the PTAB so more Americans, including those from traditionally under-represented and under-resourced communities, can participate in Office practice, while maintaining the Office's high standards necessary for the issuance and maintenance of robust and reliable intellectual property rights.

DATES: Comment Deadline: Written comments must be received on or before [INSERT DATE 90 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: For reasons of government efficiency, comments must be submitted through the Federal eRulemaking Portal at www.regulations.gov. To submit comments via the portal, one should enter docket number PTO-P-2022-0032 on the homepage and click "Search." The site will provide a search results page listing all documents associated with this docket. Commenters can find a reference to this notice and click on the "Comment" icon, complete the required fields, and enter or attach their comments. Attachments to electronic comments will be accepted in portable document format (PDF)

or DOCX format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

Visit the Federal eRulemaking Portal for additional instructions on providing comments via the portal. If electronic submission of and access to comments is not feasible due to a lack of access to a computer and/or the internet, please contact the USPTO using the contact information below for special instructions.

FOR FURTHER INFORMATION CONTACT: Michael Tierney, Vice Chief Administrative Patent Judge; Scott Moore, Lead Administrative Patent Judge; and/or Jamie Wisz, Lead Administrative Patent Judge; at 571-272-9797.

SUPPLEMENTARY INFORMATION:

Summary

In this request for comments, the USPTO seeks feedback and information on revising the criteria to practice before the PTAB in proceedings under the AIA. The Office is also exploring changes or improvements to training and development programs, such as the PTAB's Legal Experience and Advancement Program (LEAP), to increase opportunities for practitioners who wish to appear before the PTAB.

Background

Rules Currently Governing Practice Before the PTAB in AIA Proceedings

The Director of the USPTO has statutory authority to require a showing by patent practitioners that they possess “the necessary qualifications to render applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.” 35 U.S.C. 2(b)(2)(D). Thus, courts have determined that the USPTO Director bears the primary responsibility for protecting the public from unqualified practitioners. *See Hsuan-Yeh Chang v. Kappos*, 890 F. Supp. 2d 110, 116-17 (D.D.C. 2012) (“Title 35 vests the [Director of the USPTO], not the courts, with the responsibility to protect [US]PTO proceedings from unqualified practitioners.”) (quoting *Premysler v. Lehman*, 71 F.3d 387, 389 (Fed. Cir. 1995)), *aff’d sub nom.*, *Hsuan-Yeh Chang v. Rea*, 530 F. App’x 958 (Fed. Cir. 2013).

Pursuant to that authority and responsibility, the USPTO has promulgated regulations, administered by the Office of Enrollment and Discipline (OED), that provide that registration to practice in patent matters before the USPTO requires a practitioner to demonstrate possession of “the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service.” 37 CFR 11.7(a)(2)(ii).¹ The USPTO determines whether an applicant possesses the legal qualification by administering a registration examination, which applicants must pass before being admitted to practice. *See* 37 CFR 11.7(b)(ii). The USPTO sets forth guidance for establishing possession of scientific and technical qualifications in the General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases before the United States Patent and Trademark Office (GRB). The GRB is available at

¹ Legal representation before Federal agencies is generally governed by the provisions of 5 U.S.C. 500. However, that statute provides a specific exception for representation in patent matters before the USPTO. 5 U.S.C. 500(e). *See* 35 U.S.C. 2(b)(2)(D) (formerly 35 U.S.C. 31).

www.uspto.gov/sites/default/files/documents/OED_GRB.pdf. The GRB also contains the “Application for Registration to Practice before the United States Patent and Trademark Office.”

The rules that currently govern practice before the PTAB in AIA proceedings differ somewhat from the rules that govern other types of USPTO proceedings. In an AIA proceeding, 37 CFR 42.10(a) requires that each represented party designate a lead counsel and at least one back-up counsel. The regulation requires that the lead counsel be a registered practitioner. The regulation allows non-registered practitioners to be back-up counsel, but only “where the lead counsel is a registered practitioner” and when “a motion to appear *pro hac vice* by counsel who is not a registered practitioner [is] granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” *Id.*

The Board typically requires that *pro hac vice* motions be filed in accordance with the “Order Authorizing Motion for *Pro Hac Vice* Admission” in *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (the *Unified Patents* Order). The *Unified Patents* Order requires that a motion for *pro hac vice* admission must:

- a. Contain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding[; and]
- b. Be accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:
 - i. Membership in good standing of the Bar of at least one State or the District of Columbia;
 - ii. No suspensions or disbarments from practice before any court or administrative body;

- iii. No application for admission to practice before any court or administrative body ever denied;
- iv. No sanctions or contempt citations imposed by any court or administrative body;
- v. The individual seeking to appear has read and will comply with the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials set forth in part 42 of 37 CFR;
- vi. The individual will be subject to the USPTO Rules of Professional Conduct set forth in 37 CFR 11.101 et. seq. and disciplinary jurisdiction under 37 CFR 11.19(a);
- vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three years; and
- viii. Familiarity with the subject matter at issue in the proceeding.

Id. at 3. If the affiant or declarant is unable to provide any of the information requested above or make any of the required statements or representations under oath, the *Unified Patents* Order requires that the individual provide a full explanation of the circumstances as part of the affidavit or declaration. *Id.* at 4.

The PTAB's Legal Experience and Advancement Program

LEAP is an existing PTAB program developed by the USPTO to provide training and oral advocacy opportunities for less experienced advocates to gain practical experience in proceedings before the PTAB. LEAP is open to both registered and non-registered practitioners who have had three or fewer substantive oral arguments in any federal tribunal, including the PTAB. LEAP encourages parties to offer opportunities to LEAP practitioners by offering up to 15 minutes of additional oral argument time to parties that allow a LEAP practitioner to present substantive arguments at a PTAB oral hearing. To further incentivize parties and ensure high-quality representation, LEAP allows more experienced counsel to assist a LEAP practitioner during oral arguments, or clarify statements made by the LEAP practitioner, if needed. The PTAB also offers additional training and development opportunities to LEAP practitioners, including oral argument training and the opportunity to participate in a mock oral hearing before a panel of PTAB judges.

Request for Public Comments

The USPTO seeks written comments from the public on whether and how the PTAB's rules and procedures should be modified to expand eligibility to appear as the lead or back-up counsel in AIA proceedings. The USPTO also seeks written comments on whether and how changes should be made to PTAB training and development programs, such as LEAP, in order to expand opportunities for practitioners who seek to appear before the PTAB.

The USPTO welcomes any comments from the public on the proposals covered in Requests 1-4 in this notice. The USPTO also poses specific questions below and invites public feedback on them.

Request 1: Expanding Opportunities to Practice Before the PTAB by Allowing Non-registered Practitioners to Be Admitted to Practice Before the PTAB

The PTAB's current rules and procedures seek to ensure quality representation in AIA proceedings by requiring that any non-registered practitioners be admitted *pro hac vice* in each AIA proceeding in which they appear, and demonstrate good cause (e.g., that they are experienced litigation attorneys who have established familiarity with the subject matter at issue in an AIA proceeding). The USPTO is considering changes to PTAB rules and procedures that maintain the quality of representation while removing undue restrictions and actual or perceived barriers for practitioners who wish to appear before the PTAB in AIA trial proceedings.

Under current PTAB rules, a non-registered practitioner can only appear in an AIA proceeding if the PTAB grants a *pro hac vice* motion. *See* 37 CFR 42.10(c) ("The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose."). For example, if a party desired to be represented in an AIA proceeding by a non-registered litigation attorney, the party would file a *pro hac vice* motion. The motion would typically include a statement of facts demonstrating good cause. For example, the statement of facts might demonstrate that the individual seeking admission *pro hac vice* was an experienced litigation attorney who had an established familiarity with the subject matter at issue in the proceeding. The motion would also typically be accompanied by a declaration or affidavit of the type described in the *Unified Patents Order*. If the non-registered attorney were admitted *pro hac vice*, PTAB rules would limit that individual to serving as back-up counsel and require that a registered practitioner serve as the lead counsel.

The USPTO is considering an additional procedure by which non-registered practitioners could be admitted to practice before the PTAB, much like the procedure in

which certain district courts allow both *pro hac vice* admissions and general admissions to the court. The USPTO invites input on whether a non-registered practitioner should be required to satisfy only the fitness-to-practice standards set forth in the *Unified Patents Order* (e.g., no prior suspensions or disbarments, no prior sanctions or contempt citations, familiarity with the PTAB’s rules and Trial Practice Guide) or additional standards for admission to practice before the PTAB. The USPTO also invites comments on whether a non-registered practitioner, such as one without a certain level of experience in AIA proceedings, should be required to undergo additional training before being admitted to practice before the PTAB. Additionally, the USPTO invites comments on whether a non-registered practitioner should be required to have experience beyond that required to demonstrate good cause for *pro hac vice* admission (e.g., having served as back-up counsel in a certain number of prior AIA proceedings) before being admitted to practice before the PTAB. To the extent that additional training and/or experience is suggested, the USPTO requests detailed information regarding the benefits of requiring such training and/or experience, as well as the impacts of that requirement.

Request 2: Expanding Opportunities for Non-registered Practitioners to Appear as the Lead Counsel

Under current PTAB rules, non-registered practitioners can only serve as back-up counsel; a registered practitioner must serve as the lead counsel. *See* 37 CFR 42.10(c) (“The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose.”).

The USPTO invites comments on whether and how the USPTO should revise the PTAB’s rules and procedures to permit a non-registered practitioner who is admitted to practice before the PTAB under Request 1, or is admitted *pro hac vice* in an AIA proceeding, to serve as the lead counsel in that proceeding. The USPTO invites input on

whether a non-registered practitioner, who wishes to serve as the lead counsel, should be required to satisfy not only the fitness-to-practice standards set forth in the *Unified Patents* Order (e.g., no prior suspensions or disbarments, no prior sanctions or contempt citations, familiarity with the PTAB's rules and Trial Practice Guide), but should be required to undergo additional training. In addition, the USPTO invites comments on whether a non-registered practitioner should be required to have experience beyond that required to demonstrate good cause for *pro hac vice* admission (e.g., having served as back-up counsel in a certain number of prior AIA proceedings) before being permitted to serve as the lead counsel in an AIA proceeding. To the extent that additional training and/or experience is suggested, the USPTO requests detailed information regarding the benefits that would result from requiring such training and/or experience, as well as any impacts.

Request 3: Other Considerations Regarding Non-registered Practitioners

Requests 1 and 2 above are directed to potential modifications to PTAB rules and procedures related to non-registered practitioners. Such non-registered practitioners may have less familiarity than registered practitioners with certain matters that may arise during AIA proceedings. For example, a non-registered practitioner may have less familiarity with issues that may arise in a motion to amend, and may not be aware of specific reissue and reexamination options that might be available to a patent owner. Accordingly, the USPTO invites comments on whether any rule permitting a non-registered practitioner to be admitted to practice before the PTAB and/or to appear as the lead counsel in an AIA proceeding should also require that the non-registered practitioner be accompanied by a registered practitioner as back-up counsel. The USPTO also invites

comments on the impact on the costs of an AIA proceeding that would result from requiring that the lead or back-up counsel be a registered practitioner.

The USPTO also recognizes that circumstances may change during the course of an AIA proceeding in a way that might create a need for the services of a registered practitioner. For example, the assistance of a registered practitioner might be valuable if the patent owner contemplates or files a motion to amend. Therefore, the USPTO invites comments on whether any rule that permits a party to be represented solely by a non-registered practitioner in an AIA proceeding should require that party to subsequently retain a registered practitioner as back-up counsel upon the occurrence of certain circumstances or events.

The types of changes discussed and contemplated above may represent notable modifications to the rules and procedures that currently govern practice before the PTAB in AIA proceedings. The impacts of these types of changes may be difficult to anticipate beforehand, and may not be apparent to the USPTO or the public until well after any such changes are implemented. Accordingly, it may be desirable for the USPTO to retain flexibility to modify or refine any of the changes contemplated in this notice before they become permanent. Therefore, the USPTO invites comments on whether any of the changes to PTAB rules and procedures discussed in this notice should, if adopted, be implemented initially as a pilot program.

Request 4: Training and Development Programs and Potential Changes to LEAP

The USPTO is interested in offering training and development programs that will expand opportunities for practitioners desiring to practice before the PTAB, and thereby further the USPTO's goal of enabling more Americans to participate in the innovation ecosystem. The PTAB's LEAP is an example of such a program. As discussed above, LEAP practitioners benefit from specialized training and are given the opportunity to present mock oral arguments before a panel of PTAB judges. LEAP also incentivizes

parties in AIA proceedings to allow LEAP practitioners to present substantive arguments during PTAB oral hearings. The USPTO is considering whether other types of training or development options might further expand opportunities for those wishing to practice before the PTAB. Accordingly, the USPTO invites comments on whether there are additional training and/or development options that the USPTO should offer to increase opportunities for less-experienced practitioners to appear as counsel in AIA proceedings and/or serve as the lead counsel in AIA proceedings.

Initially, LEAP was open only to practitioners who had three or fewer substantive oral arguments in any Federal tribunal and seven or fewer years of experience as a licensed attorney or patent agent. The PTAB recently eliminated the requirement that LEAP practitioners have seven or fewer years of experience in order to expand the pool of eligible practitioners. The USPTO is considering whether there are other changes to LEAP that might further its goals. Accordingly, the USPTO invites comments on whether it should make any changes to LEAP to increase opportunities for candidates to appear before the PTAB in AIA proceedings and/or serve as the lead counsel in AIA proceedings.

Questions on Expanding Opportunities to Appear Before the PTAB

As noted above, the USPTO welcomes comments on potential proposals for expanding eligibility to appear before the PTAB in AIA proceedings and/or serve as the lead counsel in AIA proceedings in ways that would further the USPTO's goals. The USPTO also welcomes comments on whether additional training or development programs should be offered, and whether changes to LEAP should be made, to increase opportunities. The

USPTO is particularly interested in the public's input on the questions below;

commenters are welcome to address any or all of the questions:

1. Are there any changes to PTAB rules or procedures that the Office or the PTAB should make to increase opportunities to appear and/or serve as counsel and/or the lead counsel in AIA proceedings, such as any discussed in Requests 1–3 above?
 - 1.1. If you answered “yes” to question 1 as to the lead counsel, should the rules require that a non-registered practitioner have prior experience in AIA proceedings and/or have completed training before being designated as the lead counsel? What level of experience and/or type of training should be required?
2. Should any rule or procedure revised by the Office that permits a non-registered practitioner to be designated as the lead counsel in an AIA proceeding also require that any such non-registered practitioner be accompanied by a registered practitioner as back-up counsel? If not, are there any circumstances or events that might occur during the course of an AIA proceeding (e.g., the contemplated or actual filing of a motion to amend) that might warrant requiring a registered practitioner to then appear as back-up counsel?
3. Would a rule requiring that the lead counsel or back-up counsel in an AIA proceeding be a registered practitioner have a significant impact on the costs of such a proceeding? If so, what would the impact be, and would the impact be justified?
4. Should any of the changes discussed above, if adopted, be implemented as a pilot program?
5. Are there additional training and/or development programs the Office should offer to increase opportunities for less-experienced practitioners to appear as counsel and/or serve as the lead counsel in AIA proceedings?

6. Are there any changes to LEAP that the Office should make to increase opportunities to appear and/or serve as the lead counsel in AIA proceedings?

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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